

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 4-22 are now present in this application. Claims 4, 14 and 19 are independent. Claims 21 and 22 have been added, and claims 4, 6-8, 14, 16, 18 and 20 have been amended. Claims 9-13 stand withdrawn pursuant to an election of species requirement. Figure 6 has been amended. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

Information Disclosure Statements

Applicant thanks the Examiner for considering most of the references listed in the Information Disclosure Statement filed on May 4, 2004 and providing an initialed copy of the PTO-1449 form provided with the Information Disclosure Statement.

Applicant filed another Information Disclosure Statement on June 10, 2004 and respectfully requests that the references cited therein be considered on their merits by the Examiner.

Applicant also requests that the Examiner consider the two items listed in the second and third spaces under "Other Documents" on the PTO-1449 which was part of the Information Disclosure Statement filed on May 4, 2004,"

that have been lined through. Applicant is submitting a corrected PTO-1449 herewith that lists the date of publication of those two items and asks the Examiner to consider those references and provide Applicant with an initialed copy of the attached PTO-1449.

Objection to the Drawings

Applicant respectfully traverses this requirement on the ground that one of ordinary skill in the art can readily ascertain the claimed directions, and that such easily ascertained directions are not needed, nor are they traditionally shown, in drawings.

Nevertheless, in order to be fully responsive to this ground of objection, Applicant submits a proposed amended drawing Fig. 6 that shows the recited directions. No new matter is involved.

Approval of the proposed drawing amendment and reconsideration and withdrawal of this objection are respectfully requested.

Restriction Requirement

The Examiner has made the Restriction Requirement final, and has withdrawn claims 1-3 from further consideration. By this Amendment, Applicant has canceled non-elected claims 1-3. Applicant reserves the right to file a divisional application directed to claims 1-3 at a later date if so desired.

Election of Species Requirement

The Examiner has made the Election of Species Requirement final, and has withdrawn claims 9-13 from further consideration. Applicant has not canceled these non-elected claims since each of these claims depends, either directly or indirectly, from independent generic claim 4, which is believed to be allowable. Upon allowance of independent claim 4, Applicant respectfully requests examination and allowance of these withdrawn claims.

Furthermore, Applicant continues to traverse the election of species requirement for a number of reasons.

It is fundamental that for claims to be restricted to different species, those claims must be mutually exclusive – see MPEP §806.04(f). That is not the case in this Application.

The Examiner has withdrawn dependent claims 9-13 from consideration as being directed to non-elected species 2 (Figs. 9-11), and has examined claims 4-8 directed to elected species 1 (Figs. 4-8).

However, the election of species requirement overlooks the fact that claims 9-13 depend from claim 4. Because of this fact, claims 9-13 are not claimed in a mutually exclusive manner.

Accordingly, the election of species requirement is improper and must be withdrawn.

Additionally, the finality of this Office Action must be withdrawn and a new Office Action prepared and mailed that examines claims 4-13 on their merits.

Applicant also respectfully submits that new claims 21 and 22 read on the elected species because they depend from claim 4.

Claim Amendments

Applicant has amended the claims in order to overcome the rejection of the claims under 35 U.S.C. §112, second paragraph and to distinguish over the applied art.

Rejection Under 35 U.S.C. §112, 2nd Paragraph

Claims 4-8 and 20 stand rejected under 35 U.S.C. §112, 2nd Paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language is not clearly understood.

In order to overcome this rejection, Applicant has amended claim 4 to correct each of the deficiencies specifically pointed out by the Examiner. Applicant respectfully submits that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Accordingly, reconsideration and withdrawal of these rejections are

respectfully requested.

Applicant points out that claim 4 now has no “whereby” clause, but does not acquiesce in the assertion that “whereby” clauses make claims indefinite. Whether a whereby clause adds structure to a claim or serves to distinguish a claim, as mentioned in the rejection, is irrelevant to the issue of whether or not the meaning of a whereby clause is clear or indefinite.

Rejections Under 35 U.S.C. §103

Claims 4, 5, 8 and 14-18 stand rejected under 35 U.S.C. §103(a) as unpatentable over Applicant’s admitted prior art figs. 1-3 (hereinafter, “APA”) in view of U.S. Patent 5,142,178 to Kloster et al. (hereinafter, “Kloster”). This rejection is respectfully traversed.

Complete discussions of the Examiner’s rejections are set forth in the Office Action, and are not being repeated here.

While not conceding the appropriateness of the Examiner’s rejection, but merely to advance prosecution of the instant application, Applicant respectfully submits that independent claim 4 has been amended to recite a combination of elements in a core lamination structure including coupling means which are formed on each of the respective lamination sheets with features that are neither disclosed nor rendered obvious by the applied art, some of which has not been established to qualify as prior art. Applicant respectfully submits that

this combination of elements as set forth in independent claim 4 is not disclosed or made obvious by the prior art of record, including Kloster et al.

It is also noted that Figs. 1-3 of Applicant's disclosure, which have not been established to be prior art, do not disclose any coupling means for the lamination sheets. So, even if Figs. 1-3 were prior art (which they have not been established to be), the combination of Figs. 1-3 and Kloster would not result in, or render obvious, the claimed invention.

Applicant has not admitted that Figures 1-3 is prior art to them. In Fleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989) it was held that that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al v. Barron et al, 215 USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and Ex parte The Successor In Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

All that Applicant has done is to refer to Figs. 1-3 as "Conventional Art." Something can be conventional art in the sense that it is practiced in the real world at the time of Applicant's filing of this Application and may yet not be prior art to Applicant in any sense, including, for example, under 35 U.S.C. §103, which forms the basis for this rejection. See, in this regard, the relatively recent amendments to 35 U.S.C. §103(c).

Moreover, Applicant has confirmed that Figures 1-3 are based upon a previous design developed by Applicant.

Under the circumstances, the Office Action has not established that what is disclosed in Figs. 1-3 is prior art to Applicant.

Moreover, the Examiner is also advised that the initial burden to establish something as prior art is on the Office as part of its burden of making out a prima facie case of unpatentability.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicant respectfully submits that the Office has not made out a *prima facie* case of unpatentability at least because it has not made out a *prima facie* case that figs. 1-3 are prior art to Applicant.

With regard to claim 4, Applicant respectfully submits that the applied prior art (Kloster) does not disclose or suggest a caulked structure, as recited. Nor is it disclosed or suggested by the applied art, which includes Figs. 1-3 of Applicant's disclosure, which has not been established to be prior art.

With regard to Kloster, Applicant submits that it is incorrect for the Examiner to consider the caulking segment (8) and the complimentary opening (9) of a slightly larger dimension to constitute the claimed "fixedly coupled together by caulk" feature. The Examiner's attention is directed to column 2, lines 39-44 of Kloster et al., which discloses that the complementary openings are of a preselected slightly larger dimensional size and compatible configuration to nestingly receive the lamination displaced segments of an adjacent lamination in selectively spaced unconstrained aligned relationship. In addition, lines 5-9 of column 5 state that "[t]he stator assembly is then annealed with the nesting displaced segments 8 slightly spaced from compatible openings 9 in adjacent laminations so as to minimize frictionally engaging contact and concomitant core losses." In other words, the recesses are sized larger than projections to avoid frictional engagement. In Kloster et al. they are in nesting relation, not fixedly coupled by caulk.

Importantly, as can be seen in Kloster's Fig. 1, each lamination can be provided at each of the four corners thereof with one of four spaced bolt holes 7, where bolt holes 7 serve to receive through-bolts for fastening outer bearing support end caps, whereas in Applicant's claimed invention, lamination sheets are fixedly coupled together by caulking.

In summary, Applicant respectfully submits that the combination of elements as set forth in independent claim 4 is not disclosed or made obvious by

the established prior art of record, i.e., Kloster, for the reasons explained above. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

With regard to dependent claims 5 and 8, Applicant submits that claims 5 and 8 depend directly from independent claim 4 which is allowable for the reasons set forth above, and therefore claims 5 and 8 are allowable based on their dependence from claim 4.

In addition, with regard to claim 5, contrary to the Examiner's assertions at page 4-5 of the Office Action, Kloster et al. does not disclose or suggest "the respective lamination sheets are fixedly coupled by caulking successively and sequentially," as recited in pending claim 5. In Kloster et al., as set forth in lines 52-57 of column 3, "each stator lamination can be provided at each of the four corners thereof with one of four spaced bolt holes 7, holes 7 serving to receiving through-bolts for fastening outer bearing support end caps-all as known in the art and therefore not shown." However, the caulking is to make fastening by filling or sealing, and therefore Kloster's invention is not fixed by caulking but bolted together through holes 7 & end caps.

Still further, with regard to claim 8, the coupling means fixedly couple the laminated body by the engaging of the coupling portion on the respective lamination sheets. However, as explained above, Kloster et al. discloses that the lamination sheets are bolted together.

Reconsideration and allowance of claims 4, 5 and 8 are respectfully requested.

Allowable Subject Matter

The Examiner states that claim 6 would be allowable if rewritten in independent form, and that claim 7 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. §112, 2nd Paragraph.

Applicant thanks the Examiner for the early indication of allowable subject matter in this application. Claims 6, 7 and 20 have been amended as set forth above in order to overcome the rejection under 35 U.S.C. §112, 2nd Paragraph.

Applicant thanks the Examiner for allowing claim 19.

Reconsideration and allowance of claims 6, 7 and 20 are respectfully requested.

Claims 14-20

Claims 19 and 20 have been discussed above.

Independent claim 14 recites a device that includes a coupling portion specifically configured to allow caulking of a plurality of lamination sheets in a first direction and movement of a lamination sheet relative to an adjacent lamination sheet and in a second direction different from the first direction after the coupling portion is caulked.

Applicant respectfully submits that this combination of elements as set forth in independent claim 14 is not disclosed or made obvious by the prior art of record.

Applicant submits that claims 15-18 depend, either directly or indirectly, from independent claim 14, and are therefore allowable based on their dependence from claim 14 which is believed to be allowable. In addition, claims 15-18 recite further features which are not disclosed or made obvious by the applied prior art references.

Reconsideration and allowance of claims 14-20 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner (1) withdraw the election of species requirement, (2) reinstate claims 9-13 and examine them on their merits, and (3) reconsider all presently outstanding rejections and withdraw those outstanding rejections.

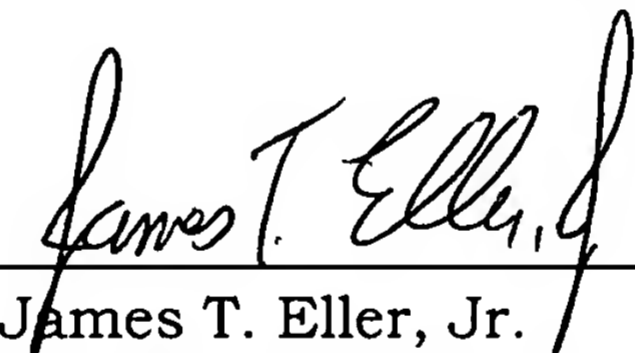
It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Jr., Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
James T. Eller, Jr.
Reg. No.: 39,538

JTE/RJW/adt

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000

Enclosure: Corrected PTO-1449
Replacement Drawing Sheet
Annotated Drawing Sheet Showing Changes



ANNOTATED SHEET

FIG. 6

